

### **REMARKS**

Claims 24-43 are pending in the present application. In the Office Action mailed October 18, 2006, the Examiner rejected claims 39-43 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. The Examiner next rejected claims 24-35 and 37-43 under 35 U.S.C. §103(a) as being unpatentable over Oyagi et al. (USP 6,199,193 – hereinafter Oyagi). Claim 36 is rejected under 35 U.S.C. §103(a) as being unpatentable over Oyagi in view of Eringis et al. (US Pub. 2003/0202638).

With regard to the rejection of claims 39-43 under 35 U.S.C. §101, the Examiner stated that “claim 39 is directed to non-statutory subject matter because a ‘signal’ is not considered statutory.” *Office Action, 10/18/06*, pg. 2. The Examiner further asserted that “[a] signal is not something that is eligible for patent rights.” *Id.* However, the Examiner did not cite any evidence or support for this position. The MPEP fails to state that a claim directed to a signal is not statutory or not eligible for patent rights. MPEP §2106 does state, however, that “[t]he burden is on the USPTO to set forth a *prima facie* case of unpatentability.” The Examiner has not satisfied this burden. The acts called for in claim 39 to which a computer data signal that represents a sequence of instructions that when executed by one or more computers to cause the one or more computers to perform produce a useful, concrete and tangible result. As such, Applicant believes that claims 39-43 are directed to statutory subject matter. Accordingly, Applicant requests withdrawal of the rejection of claims 39-43 under 35 U.S.C. §101.

The Examiner rejected claims 24-35 and 37-43 under 35 U.S.C. §103(a) as being unpatentable over Oyagi. The Examiner stated that Oyagi “does not explicitly teach that said users include *users of a newly integrated business unit*” and “does not explicitly teach that said business plan *integrates the newly integrated business unit within a business enterprise*.” *Office Action, 10/18/06*, pp. 3,4. Applicant agrees.

The Examiner then stated that “[h]owever, the fact that whether said users include *users of a newly integrated business unit*, or not, cannot affect the method steps recited.” *Id.* The Examiner also stated that “[h]owever, the fact that whether said business plan *integrates the newly integrated business unit within a business enterprise*, or not, cannot affect the method steps recited.” *Id.* The Examiner asserted that “information as to that said users include *users of a newly integrated business unit* is non-functional language and given no patentable weight” and that “information as to that said business plan *integrates the newly integrates [sic] business unit within a business enterprise*, and that the business plan *is an implemented business plan*, is non-

functional language and given no patentable weight.” *Id.* Applicant respectfully disagrees that such information is non-functional language.

The Examiner cited MPEP §2016(II)(C), which states that “[l]anguage that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.” *See Office Action, 10/18/06*, pg. 4. However, claim 24, for example, does not call for providing a feedback inputting graphical user interface optionally to users of a newly integrated business unit. Claim 24 also does not call for receiving a plurality of user feedback from individuals associated with the newly integrated business unit on a business plan, optionally implemented, that optionally integrates the newly integrated business unit within a business enterprise. Instead, such limitations are not optional and must be given patentable weight.

The Examiner further stated:

The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. *Id.*

First, MPEP §2106 does not provide that asserted by the Examiner. That is, the current revision of the MPEP, eighth edition, revision 5, does not state that which the Examiner cited. While a previous revision of the MPEP may have provided such an example, any such example was removed from the current revision.

Second, MPEP §2106.01 states that “[n]onfunctional descriptive material’ includes but is not limited to music, literary works, and a compilation or mere arrangement of data.” The subject matter identified by the Examiner in claims 24-35 and 37-43 as allegedly being non-functional language does not fit that described by the MPEP as being nonfunctional descriptive material. While the nonfunctional descriptive material listed in the MPEP is not limited to that material listed, Applicant believes that the subject matter of claims 24-35 and 37-43 contains no nonfunctional descriptive material.

Next, while the Examiner rejected claims 24-35 and 37-43 under §103, the Examiner fails to establish a *prima facie* case of obviousness thereof.

First, a *prima facie* case of obviousness requires “some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.” *MPEP §2413*. While the Examiner asserted that “it would have been an obvious matter of design choice to modify Oyagi

et al. to include that user's responses include neutral responses and too-early-to-tell responses....," such assertion of a motivation at best only applies to claims 25, 32, and 43, which include the subject matter of one or both of a neutral response and a too-early-to-tell response. The Examiner made no such assertion of a motivation with regard to claims 24, 26-31, 33-35, and 37-42. As such, with regard to a claims 24, 26-31, 33-35, and 37-42, a *prima facie* case of obviousness has not been met by the Examiner.

Second, with regard to claims 25, 32, and 43, the Examiner stated that Oyagi "does not explicitly teach that said received responses include neutral responses and too-early-to-tell responses, and that the business plan is an implemented business plan." *Office Action, 10/18/06*, pg. 4. The Examiner then stated that "[h]owever, based on common sense, it is within [sic] ability of one having ordinary skill in the art to come up with variations of possible feedbacks." *Id.*

The Examiner's reliance on "common sense" is improper. MPEP §2144.03 states:

It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 ("[T]he Board cannot simply reach conclusions based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.").

Neither the Board nor the Examiner may rely on common sense without pointing to some concrete evidence in the record to support a finding. In this case, the Examiner has not pointed to any concrete evidence in the record to support the Examiner's finding. Accordingly, the Examiner's reliance on common knowledge is improper. As such, with regard to a claims 25, 32, and 43, a *prima facie* case of obviousness has not been met by the Examiner.

With regard to claims 37 and 38, the Examiner asserted that Oyagi fails to "specifically teach that said personal information includes a name, and address, a telephone, number, a county, a zip code, a region, and email address and a sales representation name." *Office Action, 10/18/06*, pg. 5. The Examiner then asserted that "based on common sense, it is within [sic] ability of one having ordinary skill in the art to come up with variations of personal information." *Id.* As with the rejection of claims 25, 32, and 43, the Examiner has not pointed to any concrete evidence in the record to support the Examiner's finding. Accordingly, the Examiner's reliance on common knowledge is improper. As such, with regard to a claims 37 and 38, a *prima facie* case of obviousness has not been met by the Examiner.

Accordingly, that which is called for in claims 24-35 and 37-43 is not shown, disclosed, taught, or suggested in the art of record. As such, Applicant believes claim 24-35 and 37-43, and the claims which depend therefrom, are patentably distinct from the art of record.

Claim 36 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Oyagi in view of Eringis et al. Applicant respectfully disagrees with the Examiner with respect to the art as applied, but in light of claim 36 depending from what is believed an otherwise allowable claim, Applicant does not believe additional remarks are necessary and, therefore, requests allowance of claim 36 at least pursuant to the chain of dependency.

Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 24-43.

Applicant appreciates the Examiner's consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,

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